

(1) Real Party in Interest



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/486,677
Filing Date: June 26, 2000
Appellant(s): BEHLER ET AL.

Aaron R. Ettelman
For Appellant

EXAMINER'S ANSWER

Art Unit: 1621

This is in response to the appeal brief filed March 10, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: issue (1) and issue (3), with respect to GB '931, should not be considered by the Board as the Examiner is withdrawing the rejection of claims 10, 14-26 and 30 under 35 USC 103(a) as unpatentable over GB 1,172,931 in view of Naik et al. (US 4,731,378) or Grossmann et al. (US 4,999,041).

(7) *Grouping of Claims*

The rejection of claims 10, 14-26 and 30 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

7-303825	TOMINAGA ET AL.	5-1994
4,731,378	NAIK ET AL.	3-1988
4,999,041	GROSSMANN ET AL.	3-1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10, 14-26 and 30 are rejected under 35 U.S.C. Tominaga et al. (JP 7-303825) alone or in view of Naik et al. (US 4,731,378) or Grossmann et al. (US 4,999,041). This rejection is set forth in a prior Office Action, mailed on September 3, 2002, as Paper No. 18.

(11) Response to Argument

The Appellants argue that JP '825 contains no teaching or suggestion to select and combine particular degrees of ethoxylation and propoxylation by which one would arrive at amounts which fall within Appellants' claimed invention. The Examiner disagrees. JP '825 teaches that the moles of ethylene oxide (EO) should on average range between 5-15 moles and the moles of propylene oxide (PO) should on average range between 0.3-5 moles. The only additional restriction given by JP'825 is that the average number of added EO moles not exceed the given range, i.e., is not above an average of 15 moles, and the average number of added PO moles not be below 0.3 moles or exceed 5 moles. Thus, any combination of EO and PO within this range is taught and/or suggested by JP '825. Thus, for example the Appellants EO of 5 moles and PO of 2 moles falls within the EO (5-15 moles) and PO (.3-5 moles) ranges taught by JP'825. Further, JP '825 teach that one can

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achieve the lowering of the pour point by two means, one of which is controlling the carbon number distribution and the average number of added EO and PO molecules (see paragraph 0009). Thus, not only does JP '825 teach using random fatty alcohols having the EO and PO moles which overlap and/or touch the claimed EO and PO moles, but JP '825 teach that the selection of these variables has a direct effect on the pour point of the nonionic surfactant. JP '825 teaches that the pour point should be at 25°C or lower, and even preferably, 20°C or lower, and that by lowering the pour point it is possible to improve the low temperature handlability and the cleaning performance of the nonionic surfactant (see paragraph 0009). The Examiner believes that one having ordinary skill in the art would have found the claimed invention obvious over the teachings of JP '825 since JP '825 broadly teaches the claimed range of EO and PO moles, gives disadvantages for exceeding the EO moles and going below or above the PO moles, and teaches that lowering of the pour point is possible by controlling the average number of added EO and PO molecules.

The Appellants argue that JP 825 teaches away from Appellants' claimed invention because JP '825 suggests that the disclosed surfactants should contain at least 7 moles of EO per mole fatty alcohol and does not contain a single example of surfactants having 5 moles of EO per mole fatty alcohol. The Examiner disagrees. Although JP '825 teaches a preference for moles of on average between 7 and 15 moles, JP '825 also teaches that an average of 5 moles of EO can be added. Further, although JP '825 teaches that the moles of EO should not exceed 5-15 moles because the surfactant will be insufficient for practical use due to an unsatisfying cleaning performance, JP '825 contains no such disadvantage for using EO moles of on an average of 5 (see paragraph 0001).

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The Appellants argue that JP '825 do not provide one having ordinary skill in the art with a reasonable expectation of success. The Examiner disagrees. One having ordinary skill in the art would reasonably believe that the selection of any combination of the EO and PO moles, including the claimed EO and PO moles, disclosed by JP '825 would allow the artisan to obtain a polymer comprising random fatty alcohol alkoxylate having good fluidity at low temperatures and an excellent cleaning performance, as long as the EO moles do not exceed 15 moles and the PO moles do not go below 0.3 moles or exceed 5 moles.

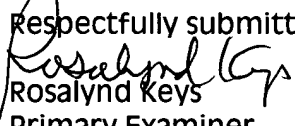
The Appellants argue that even if a prima facie case of obviousness is established that any such prima facie case of obviousness is overcome by Appellants' showing of unexpected results. The Examiner disagrees. First, the evidence presented in Appellants' specification is not representative of the closest prior art. The comparative examples given in Appellants' specification are based upon block polymers (see page 7 of Appellants' specification), whereas the claimed invention and JP '825 are based upon random polymers. Second, the results obtained by Appellants are not unexpected. JP '825 teach that the pour point can be lowered by controlling the carbon number distribution and the average number of added ethylene oxide and propylene oxide molecules (see paragraph 0009). Thus, JP '825 already suggests that the use of a compound obtained by random addition of, on an average 5-15 moles of EO and 0.3-5.0 moles of PO and containing at least 50 wt% of saturated fatty higher alcohol with 8 to 18 carbon atoms will allow one to obtain a nonionic surfactant having good fluidity at low temperatures as well as excellent cleaning performance (see paragraphs 0004 and 0005).

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The Naik et al. and Grossman et al. references were added only to show that it is known to use nonionic surfactants in agrochemicals and pesticides, as set forth in claim 24.

Note: In response to Appellants' Traversal in point B on page 13 of the brief the Examiner wishes to clarify that the rejection in Paper No. 9 based upon JP '825 was a rejection of claims 10-13, 15-18, 20-25 and 27-29 under 35 USC 102(b). This rejection was withdrawn due to the amendment filed on April 11, 2001 by Appellants as Paper No. 10.

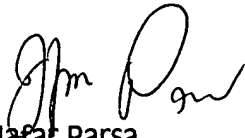
For the above reasons, it is believed that the rejections should be sustained.

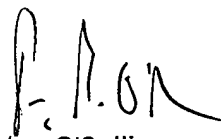
Respectfully submitted,

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January 18, 2005

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